

## **REMARKS**

By this Amendment, Applicant has amended claims 1 and 4-6. No new matter has been added. Claims 1-25 are present in the application and are pending on the merits.

In the Office Action, claims 1, 4, 8, 19, and 22 were rejected under 35 U.S.C. § 102(b) based on Morszeck (U.S. Patent No. 5,201,867); and claims 1-25 were rejected under 35 U.S.C. § 103(a) based on Skarne (U.S. Patent No. 6,055,992) combined with either Neckermann et al. (U.S. Patent No. 3,496,575) and Morszeck or Neckermann et al. and Morszeck in combination with Gueret (U.S. Patent No. 5,865,194). Claims 1 and 4 are the only independent claims rejected under § 102(b) based on the Morszeck reference, and Applicant has amended those claims, thereby obviating that rejection. Claims 1, 4, and 16 are the only independent claims rejected under § 103(a) based on Skarne (U.S. Patent No. 6,055,992) combined with Neckermann et al. (U.S. Patent No. 3,496,575) and Morszeck, and as discussed below, Applicant respectfully traverses that rejection at least because there is no suggestion or motivation to combine those reference teachings in the Office Action's proposed, hypothetical manner. Therefore, Applicant respectfully submits that claims 1-25 are allowable at least for the reasons outlined in more detail below.

### **Independent Claim 1**

The M.P.E.P. provides that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." § 2131 (citation omitted). Furthermore, the M.P.E.P. requires that with respect to an anticipation rejection relying on a theory of inherency,

“[i]nherency . . . may not be established by probabilities or possibilities.” § 2112. In fact, the M.P.E.P. cautions examiners that “[i]n relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” Id. (citation omitted) (emphasis in original). Furthermore, “[t]he mere fact that a certain thing may result from a given set of circumstances is not sufficient [to support anticipation under 35 U.S.C. § 102 based on an inherency theory].” Id. (citation omitted) (emphasis added).

Applicant’s independent claim 1, as amended, recites a cosmetic product including, among other recitations, “a cosmetic composition contained in [a] recess of [a] foam core . . . .” The Morszeck reference neither explicitly nor inherently discloses at least that subject matter recited in Applicant’s independent claim 1. Furthermore, because there is nothing providing any indication that the above-outlined subject matter recited in claim 1 “necessarily flows” from the Morszeck reference, Applicant respectfully submits that under the M.P.E.P.’s guidelines, there is no disclosure in Morszeck to support a legally proper rejection under 35 U.S.C. § 102(b) based on an inherency theory.

The rejection statement asserts that the Morszeck reference discloses “a container inherently contain[ing] [sic] cosmetic product (fig. 6) comprising a base (3) and a cover (5) forming [sic] at least partially of foam (col. 6, lines 17-20), a hinge (22) connecting the base [(3)] and the cover [(5)], at least one recess (36) forming [sic] within the foam materials, a fabric (8) covering material covering at least the base [(3)], the cover [(5)] and the hinge [(22)] (fig. 6 and col. 4, lines 21-32).” Office Action at 2.

Applicant respectfully disagrees with the rejection statement's assertion about what the Morszeck reference discloses. Looking to the reference itself, the Morszeck reference discloses a photoequipment bag 1 having a fabric coating 8 made of a nylon tissue. The front side and the transverse sides of the bag 1 may be fitted with pockets 10, 12, and 14, which may be closed by velcro or zip fasteners 16. Referring to Fig. 5, which shows a cross-section of the bag 1 shown in Fig. 3, a container part 3 and a closing part 5 are provided with a plastic layer 7 forming the internal layer of a wall of the bag 1. The plastic layer 7 is formed of a relatively thin-walled thermoplastic material, which forms a deep inner tub for the container part 3 or a flat tub-shaped inner surface for the closing part 5. A foam layer 9 "preferably consisting of a hard foam material" is located between the fabric coating 8 and the plastic layer 7. Morszeck further discloses that a photoequipment bag of such a configuration is light and waterproof.

Nevertheless, the Morszeck reference does not disclose a cosmetic product including, among other recitations, "a cosmetic composition contained in [a] recess of [a] foam core . . . ," as recited in Applicant's independent claim 1, at least because the Morszeck reference does not explicitly mention either a "cosmetic product" or a "cosmetic composition." Furthermore, Applicant respectfully submits that the above-recited subject matter is not inherent from the Morszeck reference because it does not "necessarily flow" from the Morszeck disclosure. In fact, the Morszeck reference is not relevant to anything even remotely related to cosmetic products and/or cosmetic compositions. Rather, it relates to a waterproof photoequipment bag. Therefore, the Morszeck reference cannot anticipate claim 1, either explicitly or inherently, under the

M.P.E.P.'s guidance. See § 2112. Accordingly, independent claim 1 is patentably distinguishable from the Morszeck reference.

Turning to the § 103(a) rejection of independent claim 1 based on the Office Action's proposed, hypothetical combination of the Skarne, Neckermann et al., and Morszeck references, the Office Action acknowledges that "Skarne does not disclose a fabric covering material covering at least a portion of the foam core and defining an exterior surface of the cosmetic product, wherein the covering material comprises a material other than foam and the covering material being lycra." Office Action at 3. The Office Action asserts, however, that "Neckermann et al discloses a cosmetic container (fig. 3) having a decorative stitched exterior (fabric);[ ] [sic] the container further having a recess containing cosmetic composition (lipstick 34). Id. at 4. Furthermore, the Office Action asserts that "Morszeck discloses a foam container . . . having a fabric covering on the outer surface." Id. The Office Action thereafter concludes that it would have been obvious "to employ the covering material as taught by Neckermann et al. and Morszeck into the cosmetic compact of Skearne [sic] for the purpose of providing an aesthetic look." Id. Applicant respectfully traverses the rejection of those claims because the Office Action fails to establish a *prima facie* case of obviousness.

In order to establish a *prima facie* case of obviousness, among other requirements, "there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one having ordinary skill in the art, to modify the reference or to combine reference teachings." M.P.E.P. § 2142. In other words, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." Id. at § 2143.01 (citation omitted).

The Office Action fails to establish that Applicant's independent claim 1 is *prima facie* obvious at least because there is no suggestion or motivation to modify the Skarne reference in view of the Neckermann et al. and Morszeck references in the hypothetical manner proposed in the rejection statement. Accordingly, Applicant's independent claim 1 is not *prima facie* obvious, and therefore, the Office Action's rejection under 35 U.S.C. § 103(a) based on Skarne in view of Neckermann et al. and Morszeck is improper and should be withdrawn.

For reasons at least similar to those outlined in the Request for Reconsideration filed March 29, 2004, Applicant respectfully submits that the Office Action has not established that there would have been any suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the Skarne cosmetic compact based on the teachings of either Neckermann et al.'s carry-all hat or Morszeck's waterproof photoequipment bag. Rather, the Office Action asserts a mere unsupported conclusion that Neckermann et al.'s disclosure relating to carry-all hats and Morszeck's disclosure relating to waterproof photoequipment bags could be combined with Skarne's cosmetic compact. In so doing, the Office Action has simply used Applicant's own teachings against him.

Applicant's independent claim 1 recites a cosmetic product including, in pertinent part, "a covering material covering at least a portion of [a] foam core and defining an exterior surface of the cosmetic product . . . ." The Skarne reference does not disclose at least that subject matter recited in Applicant's claim 1.

There is absolutely no suggestion or motivation to make the Office Action's proposed, hypothetical combination. The Skarne reference discloses a cosmetic

compact including a housing 20, a mirror 22, and an inner cosmetic compartment 24 that contains make-up powder. The housing 20 is composed of an elastomeric foam, such as a polyurethane or rubber foam. The exterior of the housing “preferably” has a matte surface. Col. 2, lines 12-13. The housing 20 includes two coextensive flaps 26 and 28 for holding the mirror 22 and the cosmetic compartment. The flaps 26 and 28 are hinged integrally at anchor region 30.

The Skarne reference does not disclose a covering material covering at least a portion of a foam core and defining an exterior surface of a cosmetic product. Nor does the Skarne reference contain any teaching, either explicit or implicit, of providing the Skarne cosmetic compact with any surface or covering other than the “prefer[red] . . . matte surface” discussed in the reference. Simply stated, Skarne does not recognize or suggest even a need for providing a covering to the Skarne cosmetic container. Accordingly, there would have been no reason for one of ordinary skill in the art to make any modification to that structure.

Turning to the Neckermann et al. reference, that reference discloses a carry-all hat 10 having upper and lower vertically separated compartments 16 and 18, respectively. A bottom end of the lower compartment 18 is open and serves as a head receiving cavity for the wearer of the hat 10. The upper compartment 16 contains removable objects such as lipstick 34, a hairbrush 36, and/or pill boxes 38. The hat 10 may have either a generally cylindrical shape (Figs. 1 and 3) or a generally square shape (Fig. 2) and may include an outer beaded, stitched, or otherwise shaped, decorated surface 12. A partition 14 divides the hat 10 into the upper compartment 16 and lower compartment 18. A top horizontal lid 28 is hingedly secured the upper compartment 16 and provides access to the interior of the upper compartment 16 and

may carry a decoration 32, which serves as a knob for opening and closing the lid 28.

Feathers 42 may also be secured to the periphery 40 (Fig. 5) for decoration.

As outlined above, Morszeck discloses a waterproof photoequipment bag 1 having a fabric coating 8 made of a nylon tissue. A plastic layer 7 formed of a relatively thin-walled thermoplastic material forms a deep inner tub for a container part 3 or a flat tub-shaped inner surface for a closing part 5. A foam layer 9 “preferably consisting of a hard foam material” is located between the fabric coating 8 and the plastic layer 7.

Neckermann et al.’s carry-all hat is not a cosmetic compact. It is a hat. No one having ordinary skill in Skarne’s art relating to cosmetic compacts would look to Neckermann et al.’s disclosure relating to hats for guidance.

Like Neckermann et al., Morszeck’s waterproof photoequipment bag is not a cosmetic compact. It is a photoequipment bag. No one having ordinary skill in Skarne’s art relating to cosmetic compacts would look to Morszeck’s disclosure relating to photoequipment bags for guidance.

Furthermore, since the subject matter disclosed in Skarne provides a preferred matte exterior surface, Skarne teaches away from any modification that would destroy that preferred subject matter. Thus, there would have been no suggestion or motivation in either the Skarne reference, the Neckermann et al. reference, the Morszeck reference or elsewhere, to make the Office Action’s proposed, hypothetical modification to the Skarne cosmetic compact.

Therefore, there is no legally proper suggestion or motivation to modify the Skarne cosmetic compact in view of either the Neckermann et al. hat or the Morszeck photoequipment bag. Accordingly, independent claim 1 is patentably distinguishable

from the Skarne, Neckermann et al., and Morszeck references, taken singly or in combination.

Because the Morszeck reference does not disclose all of the subject matter recited in Applicant's independent claim 1, and because the Office Action has failed to set forth a *prima facie* case of obviousness with respect to claim 1, Applicant respectfully submits that the Office Action's § 102(b) rejection of claim 1 based on Morszeck and the Office Action's § 103(a) rejection of claim 1 based on its proposed, hypothetical combination of Skarne, Neckermann et al., and Morszeck are improper and should be withdrawn.

#### Independent Claim 4

In the Office Action, Applicant's independent claim 4 was rejected under 35 U.S.C. § 102(b) based on the Morszeck reference. Applicant's independent claim 4 recites a cosmetic product including, among other recitations, "a cosmetic composition contained in [a] recess of [a] base." For reasons at least similar to those outlined above with respect to claim 1, the Morszeck reference neither explicitly nor inherently discloses at least that subject matter recited in Applicant's independent claim 4.

Turning to the Office Action's 35 U.S.C. § 103(a) rejection of claim 4 based on the Office Action's proposed, hypothetical combination of the Skarne, Neckermann et al., and Morszeck references, for reasons similar to those outlined above with respect to claim 1, the Office Action's combination of those references is improper under the M.P.E.P.'s guidance. Therefore, claim 4 is patentably distinguishable from those references.



### Independent Claim 16

In the Office Action, Applicant's independent claim 16 was rejected under 35 U.S.C. § 103(a) based on the Office Action's proposed, hypothetical combination of the Skarne, Neckermann et al., and Morszeck references. For reasons similar to those outlined above with respect to claim 1, claim 16 is patentably distinguishable from those references.

In the Office Action, claims 3 and 6 were rejected under 35 U.S.C. § 103(a) based on Skarne combined with Neckermann et al., Morszeck, and Gueret (U.S. Patent No. 5,865,194). Claims 3 and 6 depend from claims 1 and 4, respectively. Therefore, those claims should be allowable for at least the same reasons claims 1 and 4 are allowable.

### Conclusions

For at least the reasons set forth above, independent claims 1, 4, and 16 should be allowable. Dependent claims 2, 3, 5-15, and 17-25 each ultimately depend from one of those independent claims. Consequently, the dependent claims should be allowable for at least the same reasons claims 1, 4, and 16 are allowable.

Therefore, Applicant respectfully requests the reconsideration of this application, the withdrawal of the outstanding claim rejections, and the allowance of claims 1-25.

If the Examiner believes that a telephone conversation might advance prosecution, the Examiner is cordially invited to call Applicant's undersigned attorney at 571-203-2739.

Applicant respectfully submits that the Office Action contains numerous assertions concerning the related art and the claims. Regardless of whether those

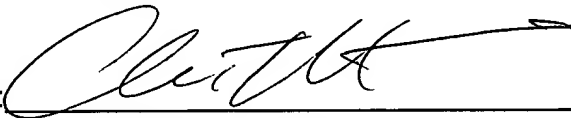
assertions are addressed specifically herein, Applicant respectfully declines to automatically subscribe to them.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 6-0916.

Respectfully submitted,

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